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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,195	03/08/2001	Andrew C. Preston	7000-052	6689
27820	7590	08/16/2004	EXAMINER	
WITHROW & TERRANOVA, P.L.L.C.			VINCENT, DAVID ROBERT	
P.O. BOX 1287			ART UNIT	
CARY, NC 27512			PAPER NUMBER	

2661

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,195

Applicant(s)

PRESTON ET AL.

Examiner

David R Vincent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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1. Claims 1-5, 9, 12, 14-17, 21, 24, 30-35 specify the phrase "adapted to" and it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster (US 6,584,490).

Schuster discloses a module (408, Fig. 6) comprising a network interface (600), a control system (604 and related elements), providing a server function (SIP UAS, col. 13, lines 46-60) "adapted to" control packet switched phones (multiple PIDs/PDAs 110, 210, 310, 410, which can be phones, col. 22, lines 56-61; col. 21, lines 18-24; col. 7, lines 24-30; col. 11,

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lines 25-29; col. 27, lines 4-34), using a first protocol (Figs. 6-8 10-11, clearly there are a plurality of protocols that are being used but any of ones shown in Figs. 10-11 or the protocols used at the physical layer for the various connections also read on the limitation), and a second protocol (SIP, Figs. 1-11; cols. 12-14), a telephone interface (interface to PIDs, 610, 612, 618), initially configure (reads on setting up calls and the calls from the PID go through the SIP phone e.g., 408, col. 13, lines 29-col. 14, line 16), control features where the features are claimed as being configurations settings, responses or functions (the calls from the PID go through the SIP phone e.g., 408, col. 13, lines 29-col. 14, line 16; col. 10, lines 16-32; Figs. 6-7), a web server function "adapted to" use a web browser (web browser location is not further defined and can be either part of the PDA/computer 410 or the SIP phone, the PID can access the Internet, 330, Fig. 3; col. 6, lines 37-56; PID can be a computer, col. 23, lines 19-25; using the PDA with a graphical interface, col. 20, lines 36-60; col. 25, lines 18-32; col. 21, lines 18-24; col. 7, lines 24-30, or lines 43-46; the PID can receive other data for display on the PID, col. 9, lines 27-28; data telephone can use IP and DHCP, col. 15, lines 44-50; telephone 408 may run computer operating systems, col. 17, lines 59-65), terminal proxy server (col. 13, lines 55-65), and using

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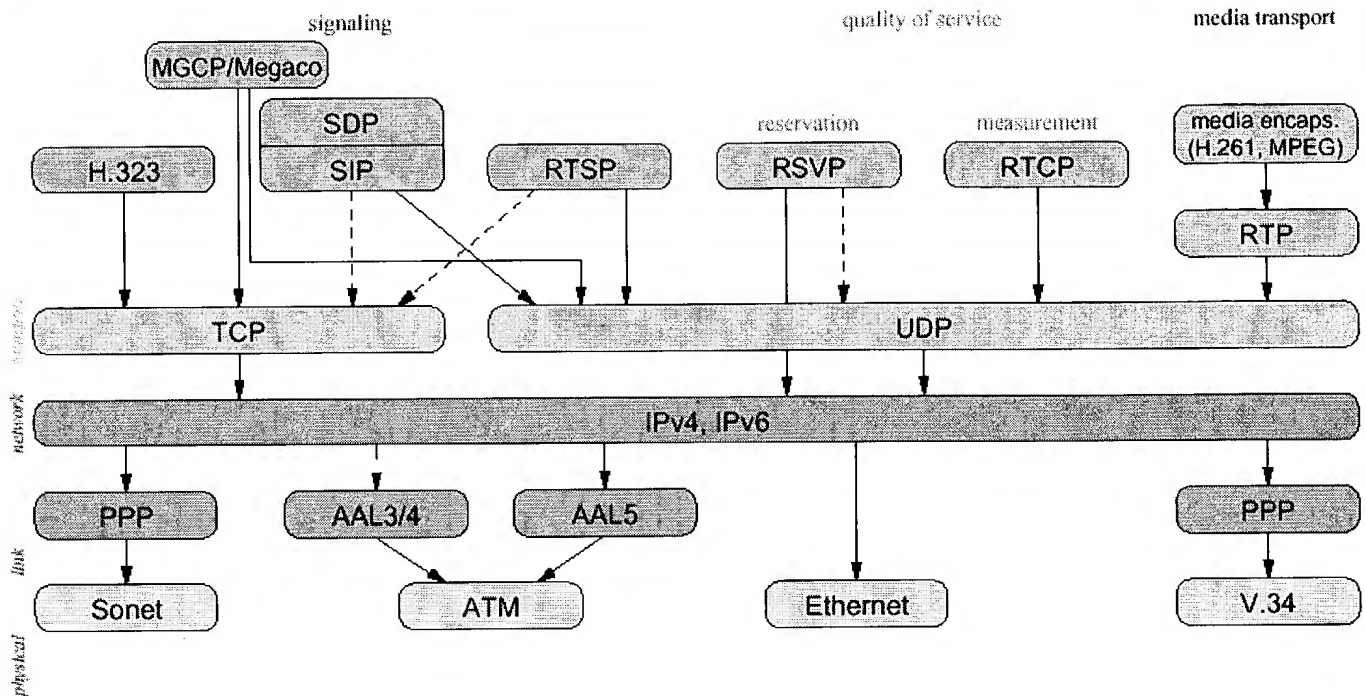
a microphone, and a speaker (col. 7, lines 53-64; 608, Fig. 6), as specified in claims 1-46. However, although Schuster mentions a plurality of phones (PIDs, col. 22, lines 41-61; col. 21, lines 45-50) Schuster fails to particularly call for a plurality of phones (PIDs/PDAs) as in connected to the same SIP phone (408).

Applicant is reminded that adding/duplicating parts for multiple effect does not make an invention patentable, see duplicating parts for a multiple effect *St. Regis Paper Co. v. Bemis Co., Inc.*, 193 USPQ 8 (7th Cir. 1977). It is considered obvious to have a plurality of phones/PDAs operating as phones because there is a plurality of telephone interfaces (e.g., 610, 612, or 618) and by using more than one a user can pick between which device they want to use for which application. The other phones may also be used for other family members.

Regarding SIP, and the terms client, server, and initiation or configuration, the applied art incorporates by reference RFC 2543 (col. 10, lines 16-34). Below are some details of the RFC or how SIP operates.

Session Initiation Protocol (SIP)

Multimedia protocol stack



SIP is an IETF signaling protocol used for establishing real-time calls and conferences over IP networks. It is an open standard and is scalable. SIP was designed to be a general-purpose protocol. It can be used for VoIP, conferencing, telephony, multimedia, instant messaging and application level mobility across various networks, including wireless, and across user devices. SIP can interact with other areas, such as the next generation wireless internets, QoS, payments and security.

SIP is an end-to-end, client-server session *signaling* protocol. It provides presence and mobility, and is used in session setup, termination, and changes. Users are provided with globally reachable addresses. A called party is contacted by using a single, location-independent address. Each session may include different types of data although currently many of the SIP extensions are directed towards audio communication. As a traditional text-based Internet protocol, it resembles the hypertext transfer protocol (HTTP) and simple mail transfer protocol (SMTP). SIP uses Session Description Protocol (SDP) for describing the media. Although, SIP cannot reserve resources it can provide information to end systems regarding what the desired QoS is. SIP is independent of the packet layer, and extensions to SIP are needed in order to make the protocol truly functional in terms of interoperability.

SIP operates using User Agents (UA), SIP Proxy Servers, SIP Redirect Servers and Registrars. The UAs, or SIP endpoints, function as clients (UACs) when initiating requests and as servers (UASs) when responding to requests. User Agents communicate with other User Agents directly or via an intermediate server. The User Agent also stores and manages call states. The SIP intermediate servers have the capability to operate as proxy or redirect servers. SIP Proxy Servers are

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used to, e.g., forward requests from the User Agent to the next SIP server, User Agent within the network and also retain information for billing/accounting purposes. SIP Redirect Servers respond to client requests and inform them of the requested server's address. Numerous hops can take place until reaching the final destination. Servers can contact external location servers to determine user or routing policies, and thus, does not bind the user into only one method of locating users. In order to maintain scalability, the SIP servers can either maintain state information or forward requests in a stateless fashion.

SIP compared to H.323

Both SIP and H.323 define mechanisms for call routing, call signaling, capabilities exchange, media control, and other services. SIP is a newer protocol which provides scalability, flexibility and ease of implementation when building complex systems. H.323 is an established protocol that has been widely used because of its manageability, reliability and interoperability with the PSTN. When standardized procedures are specified, seamless interworking between the two protocols will be possible.

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Regarding the limitations pertaining to web pages, although the exact terms are not used in the applied art, it is considered obvious that web pages can/are brought into the PID/PDA which may be any sort of a computer device and is clearly connected to the Internet (Fig. 4). The computer (410) would/does ask for the web pages from the terminal (408).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David R Vincent whose telephone number is 703 305 4957. The examiner can normally be reached on M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Olms can be reached on 703 305 4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David R Vincent
Primary Examiner
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August 11, 2004